

From: LUCAS & MERCANTI, LLP

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UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: HEARD, Thomas Sweeney Art Unit: 1654
Re: Application of: GREENWALD, Richard B., et al.
Serial No.: 10/705,740
Filed: November 11, 2003
For: **PRODRUGS OF VANCOMYCIN WITH
HYDROLYSIS RESISTANT POLYMER
LINKAGES**
Confirmation No.: 4315

RESPONSE

VIA FACSIMILE 571-273-8300

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

July 27, 2006

Sir:

Responsive to the Office Action dated June 29, 2006, the following remarks are made:

A. RESTRICTION REQUIREMENT

In response to the restriction requirement, Applicants elect to prosecute in this patent application Group I, claims 1-26 and 33, drawn to vancomycin-polymer conjugates. This response is made with traverse and it is urged that the claims contained in Groups I-III be examined together. Reconsideration is respectfully requested.

It is noted that all Groups I-III are identically classified in class 514, subclass 2+. As such, the search directed to the invention of the elected Group I will completely overlap a search strategy directed to the invention of the non-elected Groups II and III. Accordingly, Applicants urge that there would not be an undue burden upon the Examiner to search and consider Groups I-III at the same time.

In addition, the Examiner has the discretion to prosecute all of the pending claims in a

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single patent application. In fact, “[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (Emphasis added; Manual of Patent Examining Procedure, § 803, second paragraph).

Thus, for reasons of efficiency in prosecution and searching, it is urged that Groups I-III be examined together and the Examiner is respectfully requested to reconsider and withdraw the present Restriction Requirement.

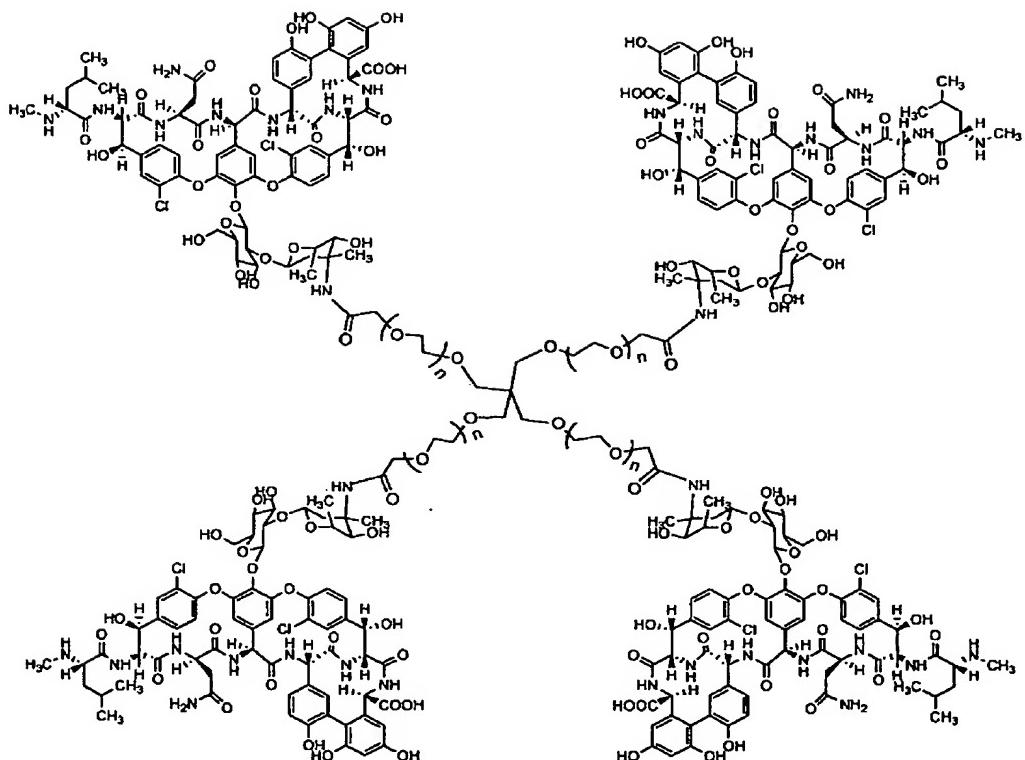
There is no change in inventorship based upon this selection.

B. ELECTION SPECIES

In response to the election of species requirement, Applicants elect to prosecute the species corresponding to compound 9 as described in Example 6 and Figure 2 in the event that no generic claim is finally held allowable. It is believed that claims 1, 6, 7 (drawn in part to the second bifunctional linker), 9 (drawn in part to the multi-armed polyalkylene oxide residue), 10, 21 (drawn in part to the first compound), 22, 23, 24 (drawn in part to the third compound) and 26 (drawn in part to the second compound) currently read on the elected species.

Compound 9 is a species of the genus described as Formula (I) and has each the sugar group of four equivalent vancomycins conjugated to one equivalent 4-armed polyethylene glycol. Compound 9 has the following structure:

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With regard to Formula (I) of claim 1, compound 9 corresponds to:

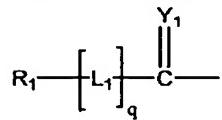
R₃ is H;

R₄ is CH₃;

R₆ is OH;

w is 1;

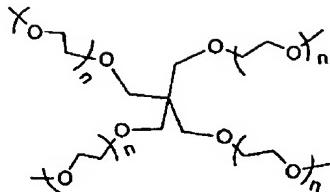
Q_a is a residue of the formula



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wherein

R₁ is



n is 227;

Y₁ is O;

L₁ is CH₂;

q is 1; and

Q_b is H.

This response to the requirement of the election of species is also made with traverse.

Reconsideration is therefore respectfully requested. It is believed that all the compounds of claim 1 should be examined together and that the differences of species is not such as to require separate examinations. Each compound corresponding to Formula (I) in the generic claim includes the same elements, i.e. the polymer portion (R₁ group) and vancomycin. Accordingly, it is urged that, in the interest of efficiency in prosecution, all the species be examined together.

D. REJOINDER

Applicants reserve the right to request rejoinder of all appropriate claims removed by the Examiner in the event that the traversal is not deemed persuasive.

E. FEES

This response is being filed within the shortened period for response. Thus, no further fees are believed to be required. If, on the other hand, it is determined that any further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated

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therewith is to be charged to Deposit Account No. 02-2275.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

LUCAS & MERCANTI, LLP



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Response is
being facsimile transmitted to the
Commissioner for Patents on the
date shown below.

July 27, 2006

LUCAS & MERCANTI, LLP

BY:



Michael N. Mercanti